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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/715,174

11/17/2003

Naomi F. Moncypenny

MANY-05

4108

53928 7590 08/08/2007
MANYWORLDS, INC.
510 BERING DRIVE
SUITE 470 (IP DEPARTMENT)
HOUSTON, TX 77057

EXAMINER

BRINICH, STEPHEN M

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

08/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10715174	11/17/03	MONEYPENNY ET AL.	MANY-05

MANYWORLDS, INC.
510 BERING DRIVE
SUITE 470 (IP DEPARTMENT)
HOUSTON, TX 77057

EXAMINER

Stephen M. Brinich

ART UNIT	PAPER
2625	20070803

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

<p align="center">Office Action Summary</p>	Application No. 10/715,174	Applicant(s) MONEYPENNY ET AL.	
	Examiner Stephen M. Brinich	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/17/03, 5/22/06</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 48-51 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 48-51 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.

Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized.

Claims 48-51, while defining an article comprising a medium storing instructions, does not define a "computer-readable medium" and is thus non-statutory for that reason. An article comprising a medium storing instructions can range from paper on which the program is written, to a program simply contemplated

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and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" in order to make the claim statutory.

In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." - MPEP 2106.IV.B.1(a)

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-7, 10-14, 16-22, 26-27, 31-38, 40-41, 45-46, & 48-51, insofar as claims 48-51 are understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Gupta et al (US 6826534).

Re claims 1, 21-22, 38, 45 48 & 51, Gupta et al discloses (column 7, lines 52-60; column 9, lines 4-22; Figures

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1, 6, 14, & 16A) a method for customizing media delivery by profiling a media customer in accordance with customer preferences and automatically (by a computer, document server 100) providing media content consistent with this profile (e.g. a list of interests). The customized media is downloaded (i.e. electronically delivered) to the customer's computer and may, upon customer request, be produced in printed form (column 4, lines 48-50; Figure 1, printing device 320) as a custom print document.

Re claim 2, Gupta et al further discloses (Figure 12) that the customized media is produced in a layout consistent with the preferences profile (i.e. including the items consistent with listed interests).

Re claims 3-5, 11, 17, 19, 34, 41, 46, & 49-50, Gupta et al further discloses (column 6, line 59 - column 7, line 20) automatically obtaining customer print histories (indicating affinities between a given customer and various content sources, and hence between the various content sources selected by a given customer). These are used to determine the layout and scheduling of delivered content and to obtain both direct and indirect (column 7, lines 3-5) assessments of customer affinities via content usage patterns.

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Re claim 6, examples of the Gupta et al content sources (Figure 12) include newspapers and magazines (e.g. TIME, USA TODAY).

Re claims 7, 10, 12, 16, & 40, Gupta et al discloses (column 9, lines 60-65; Figure 6) that customer profile data is obtained using a survey conducted electronically via a computer dialog box (inherently generated via software).

Re claims 13-14, Gupta et al discloses (column 4, lines 36-46) that communication between the customer and the content provider (which would necessarily include the above described customer profile information) may be transmitted by various means including the Internet.

Re claim 18, insofar as royalty payments are charged for documents (column 8, lines 66-67), a customer's selections of documents are readable upon the recited "buying habits".

Re claim 20, the assembly of the custom print document includes at least one manual step (the entry of customer preference data into a form such as that shown in Figure 6).

Re claim 26-27, Gupta et al discloses (column 12, lines 4-7) providing statistical information about customer preferences to advertisers in order to customize advertisement content placed within custom documents (e.g. Figure 11C) accordingly.

Re claims 31-33, Gupta et al discloses (e.g. Figure 9B) referencing Internet sites indexing specific content within the custom print document (for example, the TIMEdaily article with the time.com URL and the TIMEdigital article with the timedigital.com URL comprises a specific combination of content derived from associated Internet sites).

Re claim 35-36 & 41, the association described in the previous subparagraphs includes a formatting of content information (the articles) in accordance with associated and selected meta-information related thereto (the URLs), at least to the extent of correctly pairing articles with corresponding URLs.

Re claim 37, advertising content (e.g. Figure 11C) shows a similar layout formatting such that content information (the advertisement text) and related information (the URL) are correctly paired in the document layout.

Re claim 40, Gupta et al discloses (Figure 1; column 3, line 66 - column 4, line 9) the use of a content network comprising a plurality of information objects.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 8-9, 15, 23-25, 28-30, 39, 42-44, & 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta et al.

Re claims 8-9 & 42, Gupta et al discloses the obtaining of customer preferences for inclusion in a custom document via an electronic form rather than person-to-person interview, via mail, via Internet site subscription information, or via manual surveying.

The use of one particular method of obtaining customer information based upon factors such as cost, customer perception and resulting customer relationships, etc would be a selection among equivalents of a type judicially recognized as obvious to one of ordinary skill in the art (In re Ruff, 118 USPQ 343), unless the reason for the selection was to solve an existent problem with other known selections.

Re claim 15, Gupta et al does not specify that the above described affinities between a given customer and various content sources are determined via click streams.

Insofar as a computer interface uses mouse clicks, selections made via computer will inherently include click

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streams. The use of a well-known interface using a mouse (e.g. Microsoft Windows™) would be an expedient obvious to one of ordinary skill in the art.

Re claims 23-25, 28-30, & 43-44, Gupta et al does not specify whether an individual, an organization, or an individual within an organization is the customer (and thereby the advertising recipient and user of the Internet to obtain the custom documents) for the described customized media.

Any specific case will necessarily read on one or the other of "organization" or "individual". The use of the Gupta et al system by customers of any of these specified types so that both individuals and organizations may receive the customized documents described therein for the purpose of obtaining only relevant information (as described by Gupta at column 1, line 64 - column 2, line 1) would be an expedient obvious to one of ordinary skill in the art.

Re claim 47, Gupta et al does not disclose geographical definition of an organization.

The use of the Gupta et al system by a particular organization defined by geography (e.g. a government whose operations pertain to a specific city, state, or nation) so that that organization may receive the customized documents described therein for the purpose of obtaining only relevant information

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(as described by Gupta at column 1, line 64 - column 2, line 1) would be an expedient obvious to one of ordinary skill in the art.

Conclusion

7. Any inquiry concerning the contents of this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430.

Any inquiry relating to the status of this application or proceeding or any inquiry of a general nature concerning application processing should be directed to the Tech Center 2600 Customer Service center at 571-272-2600 or to the USPTO Contact Center at 800-786-9199 or 571-272-1000.

The examiner can normally be reached on weekdays 8:00-5:30, alternate Fridays off.

The examiner's unit designation has been changed from "Art Unit 2624" to "Technology Division 2625" (as of March 20, 2006).

If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 571-272-7437.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 571-273-8300 (as of July 15, 2005).

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Hand-carried correspondence may be delivered to the
Customer Service Window, located at the Randolph Building, 401
Dulany Street, Alexandria, VA 22314.



Stephen M Brinich

Examiner

Technology Division 2625

smb

August 6, 2007